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In re Application of:
ROSENBERGER, RONALD JOHN
Serial No.: 10/822,051
Filed: April 10, 2004
Docket: n/a
Title: SCENTED SHOE SOLES

6/9/09
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DECISION ON PETITION
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This is a decision on the petition filed on May 29, 2009 to enter new Figure 1 to proceed with pending appeal. This decision is being considered pursuant to 37 CFR 1.181. No fee is required under this section.

The petition is **DISMISSED**

The record shows that:

1. On November 14, 2005, the examiner issued a Non-Final Rejection, where he particularly rejected claim 9 as failing to comply with the enablement requirement and objected to the drawings because they did not show every feature specified in the claims.
2. Applicant responded on March 14, 2006, stating that claim 9 was amended to "more particularly recite" the invention and figure 1 was created to include each of the claimed elements, which applicant stated did not include new matter.
3. The examiner issued a final rejection on March 27, 2006. The examiner objected to the drawings which included a feature that did not correspond to the specification. The examiner objected to the specification because it introduces new matter into the disclosure in contravention with 35 U.S.C. 132. The examiner also continued to reject claim 9 for failure to comply with the enablement requirement. The examiner stated that the description of the "ring" in the specification was not understood and it is not possible to make and/or use the invention.
4. The applicant filed an appeal brief on November 28, 2007 and again on January 17, 2008, which lead to an abandonment of the application on February 14, 2008 because the amended brief did not overcome all of the reasons for noncompliance.

5. The applicant filed a second appeal brief on January 21, 2009 and a Supplemental Appeal Brief on March 15, 2009. They were found to be defective in a Notice of Defective Appeal Brief on April 16, 2009.

6. Now, the applicant filed this petition for review by the Director of the Technology Center with a new supplemental appeal brief on May 29, 2009.

Discussion and Analysis

A review of the record indicates that the drawing objection and claim rejection are directed at the same issues. Under 37 CFR 1.83(a)¹, the drawing in a nonprovisional application must illustrate every claimed feature, with the exception of conventional features deemed not essential for a proper understanding of the invention. These features should be illustrated in a graphical drawing or labeled representation. In the final office action of March 27, 2006, the examiner stated "the drawings must show every feature of the invention specified in the claims. . . . No new matter should be entered. Applicant filed a figure to show these features but the o-ring doesn't correspond to the description provided in the specification. Also, the claims and specification describe the void, receptacle and hole and 3 different elements and now the figure shows them as one." The examiner believes that the drawings do not accurately portray each essential element of the invention, and that new matter is introduced. The examiner also objected to the drawing that the subject matter in the claims and specification (specifically related to the o-ring) is not shown correctly by the drawings. In addition, the examiner also rejected at least claim 9 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The examiner stated "The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The "void can accommodate said at least one novelty scented plug or insert comprising any embodiment of an 'O' ring around the non-wearing circumference of the entire shoe sole" is not clear. The description of the "ring" in the specification was not understood and therefore it is not possible to make and/or use the invention."

It is the policy of the USPTO in appropriate circumstances to decline to rule on a petitionable issue, when, as here, that an issue is also determinative of a rejection, and as such, is appropriate for consideration on appeal to the BPAI. In this case, the issue in the objection and rejection, as here, additionally and necessarily requires the exercise of technical skill and legal judgment in order to evaluate the facts presented, the issue is properly decided on the merits, and is properly reviewed on appeal, not petition. Under the circumstances, it is believed that the issues presented under the claim rejections and drawing objection in the instant case require the same review by the BPAI. Thus, the

¹ § 1.83 Content of drawing. (a) The drawing in a nonprovisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box). In addition, tables and sequence listings that are included in the specification are, except for applications filed under 35 U.S.C. 371, not permitted to be included in the drawings.


decision by the BPAI will be critical in determining whether or not the drawings should be accepted and entered. This petition is dismissed and deferred to the BPAI as the issue as a whole is appealable and should not be decided by petition.

Conclusion

For the foregoing reasons, the relief requested by the petitioner will not be granted. Because there were objections to the drawings under 37 CFR 1.83(a) and a rejection at least to claim 9 under 35 USC 112, the overall issue is appealable and the new matter issues contained in the new Figure 1 will not be decided by petition.

The application is being forwarded to the Supervisory Patent Examiner of Art Unit 3728 for preparation of an Appeal Conference and Examiner's Answer. Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). No extension of time under 37 CFR 1.136(a) is permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181". Any inquiry regarding this decision should be directed to Henry C. Yuen, Special Programs Examiner, at (571) 272-3468.

PETITION DISMISSED



Donald T. Hajec, Director
Technology Center 3700